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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,885	03/22/2004	Takashi Izuta	P/1596-76	3872
2352	7590	09/20/2006	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			MOORE, KARLA A	
			ART UNIT	PAPER NUMBER
			1763	
DATE MAILED: 09/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/806,885

Applicant(s)

IZUTA, TAKASHI

Examiner

Karla Moore

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-9 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP Patent No. 08-067413 to Mitsuyoshi et al. in view of U.S. Patent No. 5,672,230 to Park et al.

3. Mitsuyoshi et al. disclose a substrate treating apparatus for performing a predetermined treatment of a plurality of substrates as immersed in a heated treated solution substantially as claimed and comprising: a substrate count acquiring device (9) for acquiring a count of said substrates to be treated and a treating tank device (4) for immersing said substrates in the heated treated solution for the processing.

4. However, Mitsuyoshi et al. fail to teach a storage device for storing beforehand a relationship between count of the substrates and processing time for immersion in the heated treating solution; or a processing time determining device for determining a processing time according to said substrate count of said substrates acquired by said substrate count acquiring device, by referencing to said relationship stored in said storage device.

5. Park et al. teach monitoring sensed processing variables during a treatment process and using a main computer (storage device and processing time determining means) to display, store and process sensed data to thereby enable effective central management of the treatment process (abstract).

6. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to have provided a main computer acting as a storage device and processing time determining means in Mitsuyoshi et al. in order to display, store and process sensed data thereby enabling effective central management of a treatment process as taught by Park et al.

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7. Examiner notes that the claimed invention teaches that the storage device and the process time determining means are part of a single controller/computer.

8. With respect to claims 6, the optical sensor of Mitsuyoshi et al. is a transmission type sensor.

9. With respect to claims 7 and 8, although Mitsuyoshi et al. do not explicitly teach using different types of sensors, one of ordinary skill in the art would recognize that any sensor capable of sensing the presence of wafers could be used for counting the wafers. The courts have ruled that an express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

10. With respect to claim 9, Mitsuyoshi et al. further comprises a container rest (Figure 1, 2) for receiving a container (Figure 1, C) storing said substrates to be treated, said substrate count acquiring device counts said substrates in said container placed on said rest.

11. With respect to claim 12, Mitsuyoshi et al. disclose a substrate loading robot (10). Further, with respect to the recitation of the claim drawn to the placement of the counting device, the courts have ruled that the mere rearrangement of parts which does not modify the operation of a device is prima facie obvious. In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

12. With respect to claim 13, Park et al. teaches that data may be acquired from an external device (column 4, rows 15-18).

13. With respect to claim 14, the substrate count acquiring device in Park et al. is a computer which would be capable of acquiring key input from a control unit.

14. Claims 10-11 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyoshi et al. and Park et al. as applied to claims 59 and 12-14 above, and further in view of U.S. Patent No. 5,431,179 to Miyazaki et al.

15. Mitsuyoshi et al. and Park et al. disclose the invention substantially as claimed and as described above.

16. However, Mitsuyoshi et al. and Park et al. fail to teach shutters for opening and closing partition acting as an atmospheric barrier between said container rest and a treating tank.

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17. Miyazaki et al. teach using shutters for preventing vapor from leaking outside a process apparatus (column 5, rows 28-40).

18. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention to have provided shutters for opening and closing a partition acting as a barrier in said treating tank device in Mitsuyoshi et al. and Park et al. in order to prevent vapor from leaking outside the process apparatus as taught by Miyazaki et al.

19. Further, with respect to these claims, which recite placing the counting device at various places in the apparatus, the courts have ruled that the mere rearrangement of parts which does not modify the operation of a device is prima facie obvious. In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

20. With respect to claims 15-16, Miyazaki et al. provide a plurality of treatment sections sequentially arranged, for performing a series of treatment steps (column 3, rows 35-62). When one process is over the substrates can be transferred to the next. Further, the processing fluid in each of the sections can be drained and replaced as needed (column 3, rows 62-66).

### ***Response to Arguments***

21. Applicant's arguments filed 26 June 2006 have been fully considered but they are not persuasive.

22. In response to applicant's argument that the prior art apparatus does not disclose an intended use capable of being performed in the claimed apparatus as recited in the pending apparatus claims, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The prior art (Mitsuyoshi, Park and Miyazaki) disclose an apparatus comprising each of the claimed structures that would be capable of the intended use. Examiner also notes that the prior art apparatus would be capable of performing the intended use as the processing time determining device (computer) in Mitsuyoshi is capable of turning the substrate treating tank device "on and off" based on information supplied by sensors.

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***Conclusion***

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karla Moore whose telephone number is 571.272.1440. The examiner can normally be reached on Monday-Friday, 9:00 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on 571.272.1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karla Moore  
Primary Examiner  
Art Unit 1763  
14 September 2006